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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,958	02/11/2004	Charles J. Johansen JR.	250-181	4241

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EXAMINER

MARCANTONI, PAUL D

ART UNIT PAPER NUMBER

1755

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,958

Applicant(s)

JOHANSEN ET AL.

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/22/04 filing date.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,692,565 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because both would appear to teach the same or overlapping invention as claimed for the instant invention.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-27 are rejected under 35 U.S.C. 102(a, b, or e) as being anticipated by Price et al. '404, Tanner '785 or '976, Tucker et al. '208, Zatsepin et al., GB 1122210 (Heilman-abstract only), Bozhenov et al., Ponomarev et al., Aristov et al. (SU 1016342-abstract only), IN 162194 (Saboo), or Sirazhiddinov et al. (SU 1539178-abstract only).

All of the above cited references teach making colored cement by adding a pigment before heating or sintering to form the clinker thus anticipating the instant invention. The addition of water and an inert filler such as aggregate or sand would have been an obvious design choice for one of ordinary skill in the art because these components are merely conventional additives added to cement and concretes. The claimed method is routine mixing of components. The applicants selection of a color would have been understood because a pigment was already chosen to form the desired color for the cement product.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al. '404, Tanner '785 or '976, Tucker et al. '208, Zatsepin et al., GB 1122210 (Heilman-abstract only), Bozhenov et al., Ponomarev et al., Aristov et al. (SU

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1016342-abstract only), IN 162194 (Saboo), or Sirazhiddinov et al. (SU 1539178-abstract only) alone or in view of Johansen Jr et al. '315 or 665.

The primary references teach colored cement made by mixing a pigment prior to sintering to form a clinker. Not all references necessarily teach addition of conventional additives claimed in the instant invention even though their addition is old in the art. Johansen has been combined with the primary references to show that the addition of other conventional additives to a pigmented cement would have been old and obvious to one of ordinary skill in the art. The claimed method is the routine mixing of the components within the teaching of the prior art. . The applicants selection of a color would have been understood because a pigment was already chosen to form the desired color for the cement product. It is also noted that the Johansen secondary references teach the selection of a color for the desired final product would have been within the obvious design choice of one of ordinary skill in the art (see claims to Johansen references).

Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The term flame retardancy should be amended to flame *retardants* in all claims including claim 1 and any other claim it appears.

The terms " mixtures of the foregoing" in claim 1 and throughout the claims should be amended to ---mixtures thereof---.

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The term "taken" in claim 2 (as well as all claims it is used) should be amended to ---selected---.

The applicants may consider amending their claims using ranges starting with zero such as 0 – 100 weight percent to---up to 100 weight percent--- in all instances zero is used as a lower limit. It is common US Patent Practice to use up to claim language to indicate the lower limit zero.

The terms "having a naturally occurring color" can be deleted in claim 2.

Claim 4 is indefinite because there appears to be no difference between sand and silica sand.

The applicants should delete "effective" in claim 6.

The term "superhydrophobic" would appear indefinite throughout the claims. Is this a term that is definite and clear to one of ordinary skill in the art and what does it mean? (as opposed to just hydrophobic)

Claims 9 and 10- Retardancy should be amended to retardants and "of the foregoing" to -thereof.

Claim 11 is indefinite because silica is not distinguished from silica sand.

The term "taken" should be deleted and replaced with ---selected--- in claim 11.

Applicants may consider deleting "having a a naturally occurring color.

In claim 16, the term "preselected" in (i), "predetermined" in (iii), and "determined" also in (iii) should be deleted. Although not deleted in the '565 B2 patent, the terms should be removed because predetermined is an indefinite term and its failure

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to remove from the '565 is regretted. Deletion of these terms will not affect the scope of the process claims.

Applicants may consider removing "having a naturally occurring color or being white" in claim 21.

PTO-1449:

All references not considered were crossed out. It is believed that it is improper to cite a "website" as prior art but if this is now permissible, the applicants can relay the pertinent sections of the MPEP where it is permissible. Yet, it would not appear proper for citation on the PTO-1449. The examiner did initial those documents or brochures but just deleted the part to the website.

Also, the references crossed out were not part of the file and missing. It is also noted that some of the references inadvertently crossed out were re-inserted on the PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Paul Marcantoni', is positioned above the printed name.

Paul Marcantoni
Primary Examiner
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